

REMARKS

Claims 6, 10-11, 17, 20, 22, 27-29, 31-35, and 37 are pending in the subject application. Claims 6, 10-11, 17, 20, 22, 27-28, 32, 34-35 and 37 have been amended. Claims 1-5, 7-9, 12-16, 18-19, 21, 23-26, 30 and 36 have been canceled. No new matter is raised by these claims amendments.

It appears that the Examiner did not address claims 27-37 added in the Amendment filed on October 13, 2003. In the office action dated November 19, 2003, the Examiner erroneously noted that "Claims 6-11, 17-22 and 26 are pending in the application," and failed to indicate that claims 27-37 were also pending. Further, the Examiner did not address these claims in the office action as he neither stated that they were allowed nor did he reject them. Accordingly, Applicants respectfully request that the finality of the present office action be removed so the Examiner can fully examine these claims and allow the applicants an opportunity to respond to such examination.

Rejection of claims 6-11, 17-22 and 26 under of 35 U.S.C. §112, First Paragraph - Written Description

Claims 6-11, 17-22 and 26 stand rejected under 35 U.S.C. § 112, first paragraph, on the grounds that the claimed invention is not described in such a way that one of ordinary skill in the art would be convinced that the Applicant was in possession of the claimed genus at the time of filing.

The claims have been amended or canceled, thus rendering this ground of rejection moot. Accordingly, applicants request withdrawal of this ground of rejection.

Rejection under 35 U.S.C. § 103(a)

Claims 6-11, 17-22 and 26 have been rejected under 35 U.S.C. over Gonzalez et al. (U.S. Patent 6,015,673) in view of Willhauck et al. (Biotechniques (1998) 25:656-659).

Applicants respectfully disagree as Gonzalez does not teach each and every element of the claimed invention and Willhauck and Buck do not make up for these deficiencies. For instance, the present claims involve fixing a portion of a tumor sample in paraffin. Gonzalez does not teach or suggest this. The present claims involve isolating mRNA from the fixed and paraffin embedded (FPE) tumor tissue. Gonzalez does not teach or suggest this. The present claims involve amplifying mRNA from the FPE tumor tissue. Gonzalez does not teach or suggest this. The present claims also involve comparing expression levels of DPD in the amplified mRNA from the FPE tumor sample with the mRNA from an internal control gene. Gonzalez does not teach or suggest this. Willhauck does not teach or suggest these missing elements and does not make up for the shortcomings of Gonzalez. Thus, applicants respectfully assert that the combination of Gonzalez and Willhauck do not teach nor suggest the claimed invention and therefore do not render the claims obvious. Accordingly, applicants respectfully request withdrawal of this ground of rejection.

Applic. No. 09/842,111
Amdt. dated Feb. 17, 2004
Reply to Office Action of Nov. 19, 2003

CONCLUSION

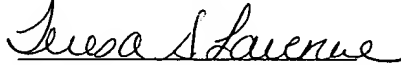
It is believed that the present claims are in conditions for allowance and earnestly request allowance. Extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 11-0600. The Examiner is invited to contact the undersigned attorney if necessary to expedite allowance.

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1500 K Street, N.W.
Washington, D.C. 20005
Telephone: (202) 220-4200
Facsimile: (202) 220-4201

Respectfully submitted,

KENYON & KENYON



Teresa A. Lavenue

Reg. No. 47,737